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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/044,287	01/09/2002	Denis Chalon	B-4457 619451-4	6861

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EXAMINER

WANG, LIANG CHE A

ART UNIT	PAPER NUMBER
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2155

DATE MAILED: 05/27/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/044,287

Applicant(s)

CHALON, DENIS

Examiner

Liang-che Alex Wang

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 04 April 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-12 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-12 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

S-000

DETAILED ACTION

1. Claims 1-12 are presented for examination.

Response to Arguments

2. Applicant's arguments filed 4/4/2005, have been fully considered but they are not persuasive.
3. In that remarks, applicant's argues in substance:
 - a. That: there is nothing in either of these two passages specifically cited by the Examiner, or anywhere else in Geiger for that matter, that teaches or alludes to presenting the email to the sender in such way that the sender can amend the email.

This is not found persuasive because Geiger has taught presenting the email to the sender (Col 11 lines 11-25, gatekeeper returns the message to the sender with the explanation as why it's returned or not delivered, see figure 21) in such a way that the sender can amend the email (Col 23 lines 37-46, Col 5 lines 57-67, in a conventional email system, the sender is able to modify and make any necessary changes to the content of the email in order to deliver the message to the intended recipient(s));

Applicant pointed out the sender of Geiger would have to manually re-open the message and edit it and does not present the returned emails in such a way that the sender can amend the email. The examiner respectfully disagree, the returned email of Geiger (for example, figure 21) contains the explanation, which

provides the information for the user to make changes to the content of the email, and in a conventional email system, a user is able to make necessary change to the content of the email upon receiving the returned email with explanation, in order to deliver the email to the remote recipients. The action of making necessary changes to the email is equivalent to the sender having capability of "amending" the email.

- b. That: there is nothing the Geiger that teaches or allude to waiting for triggering event dependent on satisfaction of the sender's criteria, nor of sending the email to the recipients upon occurrence of the triggering event.

This is not found persuasive because Geiger has taught in response to a specified triggering event (Col 3 lines 47-52, email returning to the sender is triggered when the email or its attachment exceed a certain size) dependent on satisfaction of the senders criteria (the size of the message or the number of attachments corresponds the satisfaction of the senders criteria), transmitting the email to the one or more recipient (Col 23 lines 37-46, Col 5 lines 57-67, email is eventually being delivered to the recipient).

Claim Rejections - 35 USC § 102

- 4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an

international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5. Claims 1-12 are rejected under 35 U.S.C. 102(e) as being anticipated by Geiger et al., US Patent Number 6,073,142, hereinafter Geiger.
6. Referring to claim 1, Geiger has taught a method of operating an electronic mail (email) system comprising:
 - a. enabling a sender to compose an email and initiate a send operation to one or more recipients in respect to the email (Col 5 lines 58-64, Figure 1, a conventional email client is capable of generating and receiving emails to and from other users);
 - b. intercepting the email sent by the sender (Col 10 lines 34-42, Figure 4, Col 23 lines 37-46, email messages is gated (intercepted) by the gatekeeper;
 - c. presenting the email to the sender (Col 11 lines 11-25, gatekeeper returns the message to the sender with the explanation as why it's returned or not delivered, see figure 21) in such a way that the sender can amend the email (Col 23 lines 37-46, Col 5 lines 57-67, in a conventional email system, the sender is able to amend the content of the email when receive a message (for example, figure 21) in order to deliver the message to the intended recipient(s));
 - d. in response to a specified triggering event (Col 3 lines 47-52, email returning to the sender is triggered when the email or its attachment exceed a certain size) dependent on satisfaction of the senders criteria (the size of the message or the number of attachments corresponds the satisfaction of the senders criteria),

transmitting the email to the one or more recipient (Col 23 lines 37-46, Col 5 lines 57-67, email is eventually being delivered to the recipient).

7. Referring to claim 2, Geiger has further taught wherein the triggering event includes a sender input (Col 11 lines 20-25).
8. Referring to claim 3, Geiger has further taught wherein the triggering event corresponds to a user not aborting the transmission of the email within a specified delay period, whereupon the end of the delay period, the email is automatically sent to the recipient(s) with no intervention (Figure 4b, step 449, Col 11 lines 34-37).
9. Referring to claim 4, Geiger has further taught wherein the triggering event corresponds to the sender opening the email and taking no action, then closing the email, whereupon the email is immediately sent to the recipient(s) with no further intervention (Col 11 lines 11-25).
10. Referring to claim 5, Geiger has further taught wherein the triggering event corresponds to the sender proactively confirming that the email should be sent, whereupon the email is immediately transmitted to the recipient(s) with no intervention (Col 11 lines 11-25).
11. Referring to claim 6, Geiger has further taught wherein either the sender specifies the delay period or it may be globally set (Col 9 lines 4-26).
12. Referring to claim 7, Geiger has further taught wherein the transmission step includes additional intervening steps such as spooling the email or handling the email by mail servers or any other operations as may be required by the particular email implementation or system architecture (see abstract).

13. Referring to claim 8, Geiger has further taught wherein following presenting the email to the sender, the sender amends the email and initiates a second operation in accordance with either the intercepting step whereupon the mail is again subjected to the transmission criteria, or the email is processed in accordance with the transmitting step whereupon the email is immediately transmitted to the one or more recipients with no further intervention (Figures 4A and 4B).
14. Referring to claim 9, Geiger has further taught checking whether the sender is listed as a recipient of the email and if the sender is identified as a co-recipient of the email, processing the email is processed in accordance with the presenting step, otherwise transmitting the email immediately to the one or more recipients (f Figures 4A and 4B).
15. Referring to claims 10-12 claims 10-12 encompass the same scope of the invention as that of the claims 1-9. Therefore, claims 10-12 are rejected for the same reason as the claims 1-9.

Conclusion

16. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any

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extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

17. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Liang-che Alex Wang whose telephone number is (571)272-3992. The examiner can normally be reached on Monday thru Friday, 8:30 am to 5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ario Etienne can be reached on (571)272-4001. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Liang-che Alex Wang *lw*
May 17, 2005

Bharat Barot
BHARAT BAROT
PRIMARY EXAMINER